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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,767	12/16/1999	GERALD WAYNE BOTH	50179-073	8030

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EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Advisory Action

Application No.

09/464,767

Applicant(s)

BOTH ET AL.

Examiner

Scott D. Priebe

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

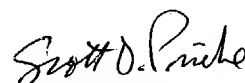
Claim(s) allowed: 28 and 48.

Claim(s) objected to: _____.

Claim(s) rejected: 25-27,29,31-37,39-47,49-51.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Scott D. Priebe
Primary Examiner
Art Unit: 1632

* Continuation of 2. NOTE: The claims as amended are not in compliance with 37 CFR 1.121. The only permitted claim status identifiers are: original, currently amended, canceled, withdrawn, new, previously presented, and not entered. Proposed claims that have been identified as "previously added" or "previously amended" should have been identified as --previously presented--; and those identified as "previously canceled" should have been identified simply as --canceled--. The proposed claim 33 recites "non-essential for to replication", which is grammatically incorrect. In claim 42 (line 6) and claim 47 (lines 5-6), the text deleted in a previous amendment should have been omitted. Otherwise, the amendment would have been entered.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant asserts that the proposed amendment would overcome the rejection for new matter. The proposed amendment to claim 25 would have overcome the new matter rejection of claims 25 and 26 had it been entered. However, no similar amendment was proposed for independent claims 31, 36, 41, 42, 45, 47 and 49, to which, along with their dependent claims, the same grounds of rejection were applied. The proposed amendment to claim 29 would have overcome the new matter rejection of claim 29, 50 and 51 had it been entered. With respect to new matter in claims 33, 34, 36-37, 39-47, and 49, proposed claims 33 and 41 would have overcome this ground of rejection of claims 33, 34, and 41 had they been entered. However, no similar amendment was proposed for independent claims 36, 42, 45, 47 and 49, to which, along with their dependent claims, the same grounds of rejection were applied.

With respect to the rejection of claims 41-44 and 47 for lack of enablement, the final rejection had indicated (page 8, para. 1) that the previous amendment overcame the grounds pertaining to the scope of the target cell. The specification must teach how to make and use the claimed method. The final Office action did not indicate that the specification did not describe OAV205, but that the vectors and subject matter described on pages 1-2 of the declaration were not supported in the original specification. The specification discloses three general in vivo uses for the method: vaccination, gene therapy, and genetic engineering to promote growth or modify production traits (para. bridging pages 23-24). The specification does not teach any other in vivo use for a method of delivering a DNA molecule.

Vaccination and vaccine are terms of art for a process of inducing protective immunity against a pathogen and the product for carrying out that process, respectively. The declaration shows that a claimed vector carrying sequences for encoding the 45W antigen is not capable of providing protective immunity on its own, and the specification does not teach using this particular vector or any other claimed vector as part of a vaccination method. This particular example described in the declaration is not commensurate in scope with the claims because it does not demonstrate vaccination, and has nothing to do with gene therapy or genetic engineering, which are the other general uses of the method taught in the specification. Also, it has nothing to do with the delivery of an anti-sense RNA or ribozyme. All the declaration shows is evidence that some protein was expressed from the vector in sheep, not that such expression achieved the goal of any of the uses described in the specification.

The proposed amendment to claim 27 only partly addresses the rejection of this claim under 35 USC 112, 2nd para. relating to "the sequence." The proposed amendments to claims 29 and 47 would have overcome the rejection of these claims under 35 USC 112, 2nd para. had it been entered.

Continuation of 10. Other: The substitute oath/declaration overcomes the objection to the previous oath/declaration..